

TOLER SCHAFFER, LLP
5000 Plaza on the Lake, Suite 265
Austin, TX 78746
Ph. 512-327-5515
Fax 512-306-8545

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DATE: March 21, 2006

TO: Examiner Escalante, Ovidio **FAX NO.:** 571-273-8300
USPTO GPAU 2645

FROM: Jeffrey G. Toler
Reg. No.: 38,342

RE U.S. App. No.: 10/714,585, filed November 14, 2003

Applicant(s): Brian K. Hollowell, et al.

Atty Dkt No.: 1033-MS1008

Title: SYSTEM AND METHOD FOR SIMPLE UNIFIED MESSAGING

NO. OF PAGES (including Cover Sheet): 9

MESSAGE:

Attached please find:

- ☒ Transmittal Form (1 pg)
- ☒ Notice of Appeal (2 pgs) (in duplicate)
- ☒ Pre-Appeal Request for Review (1 pg)
- ☒ Remarks in Support of Pre-Appeal Request for Review (4 pgs)

5000 Plaza On The Lake
Suite 265
AUSTIN, TEXAS 78746

Tel: (512) 327-5515
Fax: (512) 306-8545

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PTO/SB/21 (09-04)

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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

9

Application Number

10/714,585

Filing Date

November 14, 2003

First Named Inventor

Brian K. Hollowell et al.

Art Unit

2645

Examiner Name

Escalante, Ovidio

Attorney Docket Number

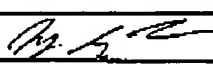
1033-MS1008

ENCLOSURES (Check all that apply)

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<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	Remarks	

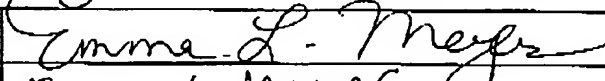
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Toler Schaffer, L.L.P.		
Signature			
Printed name	Jeffrey G. Toler		
Date	3-20-2006	Reg. No.	38,342

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Signature			
Typed or printed name	Emma L. Meyer	Date	3-21-2006

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1033-MS1008	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____		Application Number 10/714,585 First Named Inventor Brian K. Hollowell et al. Art Unit 2645	Filed November 14, 2003 Examiner Escalante, Ovidio
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record Registration number 38,342 <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34 Registration number if acting under 37 CFR 1.34 _____		_____ Signature Jeffrey G. Toler Typed or printed name 512-327-5515 Telephone number 3-20-2006 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/> Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to do (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): **Brian K. Hollowell et al.**
Title: **SYSTEM AND METHOD FOR SIMPLE UNIFIED MESSAGING**
App. No.: **10/714,585** Filed: **November 14, 2003**
Examiner: **Ovidio Escalante** Group Art Unit: **2645**
Customer No.: **60533** Confirmation No.: **1674**
Atty. Dkt. No.: **1033-MS1008**

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

**REMARKS IN SUPPORT OF
THE PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

In response to the Final Office Action mailed January 11, 2006 (hereinafter, "the Final Office Action"), Applicants respectfully request review and reconsideration of the Application in view of the following issues.

1. The Asserted Combination of Tverskoy and Alexis Fails to Disclose or Suggest At Least One Element of Each of the Claims 1-4, 6-19, 21-27, 29 and 30.

Applicants traverse the rejection of claim 1-4, 6-19, 21-27, 29 and 30 under 35 U.S.C. §103(a) over U.S. Patent No. 6,341,160 ("Tverskoy") in view of U.S. Patent Publication No. 2004/0072544 ("Alexis").

Tverskoy and Alexis fail to disclose or suggest the particular combination of features recited by the claims of the above-identified application. Claim 1 recites a Voice over Internet Protocol call. Claim 11 recites a Voice over Internet Protocol engine communicatively coupled to the network interface. Claims 21 and 29 recite that the incoming telephonic call comprises a Voice over Internet Protocol call.

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At page 3, the Office Action acknowledges that Tverskoy fails to disclose or suggest that the incoming call comprises a Voice over Internet Protocol call. *See Final Office Action*, p. 3, paragraph 5. The Office Action asserts that Alexis discloses this feature at paragraphs 0045 and 0051.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *M.P.E.P.* §2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vacck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The cited references fail to provide a motivation for making the asserted combination. Tverskoy is directed to an answering machine for transmitting messages to a remotely accessible user account. *See Tverskoy*, Abstract. The answering machine of Tverskoy includes a memory to store a voice message from a caller and a control system to store information associated with a user account and to transmit an electronic mail message including the voice message. *See Tverskoy*, Abstract. By contrast, Alexis is directed to a communication device for hosting land-line, wireless and Internet telephone calls. *See Alexis*, Abstract. Alexis discloses that the communications device allows a wireless call to be placed on hold to answer an incoming call on the landline. *See Alexis*, Abstract.

Alexis states:

To implement text/voice messaging in the context of the systems described herein, a software "plug-in" or "add-on" is provided for the instant messaging client that runs locally on the user's personal computer or similar device. The user turns on a switch within the software to allow instant messages to be sent to his/her home telephone in the event the user is away from the personal computer.

See Alexis, page 15, paragraph 0166. Thus, Alexis discloses that voice messaging is implemented as instant messaging via a software messaging client that runs locally on the user's device. *See Alexis*, p. 15, paragraph 0166.

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The Final Office Action asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tverskoy by providing Voice over Internet Protocol (VoIP) calls as taught by Alexis "so that the cost for the call can be lowered when compared with conventional telephone calls." *See Final Office Action*, p. 4, paragraph 5. However, Applicants note that Tverskoy is directed to an answering machine, not to lowering costs of telephone calls. *See Tverskoy*, Abstract. The suggested motivation provided by the Final Office Action is not supported by either reference.

Moreover, the instant messaging system of Alexis is technically inconsistent with the email and attached voicemails of Tverskoy. A person of ordinary skill in the art would not be motivated to look to the instant message client of Alexis to modify the answering machine of Tverskoy. Rather, such a combination would destroy the time-shifting functionality of Tverskoy. In particular, the real-time forwarding of instant messages to the user via the communication device of Alexis requires both users to be available at the time of the transmission. By contrast, Tverskoy records and sends a voicemail to the user, precisely because the user is not available to answer a call at that moment. The cited references fail to provide a suggestion or motivation to make the asserted combination. Therefore, the asserted combination of the instant messaging system of Alexis with the answering machine of Tverskoy is an impermissible hindsight reconstruction based on the present application. Accordingly, the Examiner has failed to meet his burden or to provide any basis to support a prima facie case of obviousness, and the rejection of claims 1-4, 6-19, 21-27, 29 and 30 over Tverskoy and Alexis should be withdrawn.

The Final Office Action acknowledges that it would not have been obvious in light of Alexis to combine a VoIP feature to the answering machine of Tverskoy. *See Final Office Action*, p. 10, paragraph 6. Nevertheless, the Final Office Action maintains the rejection, stating that the call as defined in the claims is from a calling party and that "the answering machine of Tverskoy is not modified in any way with the VoIP feature." *See Final Office Action*, p. 10, paragraph 6.

The Final Office Action is inconsistent in its stated basis for making the asserted combination, by first insisting that the combination of Tverskoy and Alexis would have been

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obvious at page 4, and then acknowledging that the combination would not have been obvious at page 10. The cited combination of Tverskoy and Alexis would not have been obvious because the teachings of Tverskoy and Alexis are technically inconsistent.

Moreover, though the Final Office Action asserts that adding VoIP features to the answering machine of Tverskoy does not modify the answering machine, the assertion is inherently contradictory. In particular, the VoIP feature cannot be added to the answering machine without modifying the answering machine, since Tverskoy fails to disclose or suggest such a feature. Consequently, the Final Office Action fails to establish a prima facie case of obviousness.

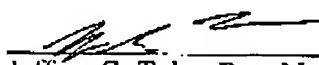
CONCLUSION

Applicants have pointed out specific features of the claims not disclosed, suggested, or rendered obvious by the references applied in the Office Action. Accordingly, Applicants respectfully request reconsideration and withdrawal of each of the objections and rejections, as well as an indication of the allowability of each of the pending claims.

The Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

3-20-2006
Date


Jeffrey G. Toler, Reg. No. 38,342
Attorney for Applicant(s)
TOLER SCHAFFER, L.L.P.
5000 Plaza On The Lake, Suite 265
Austin, Texas 78746
(512) 327-5515 (phone)
(512) 306-8545 (fax)